

Attorney Docket No.: IN01157K

PTO/SB/92 (08-03)

(Modified)

Application No.: 09/909,062

Filing Date: 07/19/2001

Applicant: Anil K. Saxena et al.

Title: "Novel Peptides as NS3-Serine Protease Inhibitors of Hepatitis C Virus"

### Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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on 08/04/2004  
Date

Signature

Palaiyur S. Kalyanaraman, Reg. No. 34,634

Typed or printed name of person signing Certificate

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Documents enclosed:

Issue Fee - 1pg.

Fee Transmittal - 1pg. in duplicate

Petition for Patent Term Adjustment - 2pgs.

Patent Term Adjustment Summary - 1pg.

Copy of Incorrect Notice of Allowance - 1pg.

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This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No.: IN 01157K  
(SCHERING 3.0-120)  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Saksena et al.

Application No.: 09/909,062

Group Art Unit: 1654

Filed: July 19, 2001

Examiner: M. Audet

For: NOVEL PEPTIDES AS NS3-SERINE PROTEASE  
INHIBITORS OF HEPATITIS C VIRUS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705**

Dear Sir:

It is respectfully requested that the "Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)" of "0 day(s)" shown on PTOL-85 mailed May 19, 2004 be revised pursuant to the instant application in order to properly reflect the patent term adjustment due the patentees of sixty (60) days. Please charge deposit account No. 19-0365 in the amount of \$200.00 pursuant to 37 C.F.R. § 1.18(e). In the event that any additional fee is due in connection with the present application, such additional fee should be charged to the same deposit account. This Application for Patent Term Adjustment is being filed concurrently with Payment of the Issue Fee in this case.

As required, Applicants include a statement of the facts involved in support of the application for adjustment of patent term. The statement of facts is presented in the form of a Table, enclosed herein, summarizing both the time credits and time debits, including: (1) the relevant dates and an explanation in support of each entry in view of §§1.703(a) through (e); (2) the circumstances during the prosecution of the application resulting in the patent that constitute a "failure to engage in reasonable efforts to conclude processing or examination" as set forth in

Application No.: 09/909,062

Docket No.: IN 01157K  
(SCHERING 3.0-120)

§1.704; and (3) the adjustment as specified in §1.703(f) to which the patent is entitled. The patent is not subject to a terminal disclaimer.

Dated: 08/04/2004

Respectfully submitted,

By 

Dr. Palaiyur S. Kalyanaraman

Registration No.: 34,634

Schering-Plough Corporation

2000 Galloping Hill Road

K-6-1 1990

Kenilworth, NJ 07033-0530

Tel: 908-298-5068

Fax: 908-298-5388

Attorney for Applicant

Enclosure

LD-453\  
45396\_1.DOC

45396 v1

**PATENT TERM ADJUSTMENT SUMMARY**  
**(Patent Application Number: 09/909,062; Filing Date July 19, 2001)**

CREDITS (DAYS)	COMMENTS	DEBITS (DAYS)	COMMENTS
13	Delay (beyond 14 months from filing date) for issuance of first Office Action-Oct. 2, 2002	95	Delay: Response dated Sept. 29, 2003 to Office Action dated March 26, 2003 (3 month petition for extension of time granted)
33	Delay (beyond 4 months) for response dated March 26, 2003 to Applicants' Reply dated Oct. 21, 2002	44	Delay: filing of supplemental IDS Nov. 12, 2003 after issuance of non-final Office Action Sept. 29, 2003 (per 37 C.F.R. §1.97(c))
153	Delay in mailing Notice of Allowance to the correct Customer: original notice mailed Dec. 18, 2003 to an unrelated third party*; corrected notice mailed May 19, 2004.	-	Petition under 37 CFR 1.181(a)(3) dated May 10, 2004, necessitated by misdirected mailing of Notice of Allowance by the Office* to unknown third party. Petition promptly filed after Applicants learned of Office error. Petition necessarily filed after response to non-final Office Action dated Sept. 29, 2003. The filing of a paper to correct an Office error cannot incur a time debit.
		-	Petition under 37 CFR 1.181(a)(3) dated May 10, 2004 also petitioned the Director to revive the presumptively abandoned application (failure to pay Issue Fees caused by Office mailing error). Petition filed after date on which Issue Fees were required to be paid; due to misdirected Notice of Allowance. Office mailed original notice of allowance to the wrong party on Dec. 18, 2003. Filing a paper to correct an Office error cannot incur a time debit.
<b>Total: 199</b>		<b>Total: 139</b>	
<b>NET PATENT TERM ADJUSTMENT DUE PATENTEE: 60 DAYS</b>			

\* See attached copy of page 1 of incorrectly addressed "Notice of Allowance and Fee(s) Due" date mailed 12/18/2003



# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 1,905.00

## Complete if Known

Application Number	09/909,062
Filing Date	07/19/2001
First Named Inventor	Anil K. Saxena
Examiner Name	Audet, Maury A.
Art Unit	1654
Attorney Docket No.	IN01157K

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit  
Account  
Number  
Deposit  
Account  
Name

19-0365

Schering-Plough Corporation

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 180	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$ ) 0.00

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	X	
Independent Claims	- 3** =	X	
Multiple Dependent			

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ ) 0.00

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	1330
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) Pub. Fee \$300, Copies \$75, PTA Petition \$200

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 1905.00

## SUBMITTED BY

(Complete if applicable)

Name (Print/Type) Palaiyur S. Kalyanaraman

Registration No. 34,634  
(Attorney/Agent)

Telephone 908-298-5068

Signature

Date 08/04/2004

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

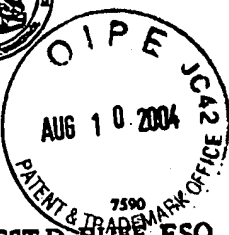
This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS  
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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov



## NOTICE OF ALLOWANCE AND FEE(S) DUE

ERNEST D. BUFF, ESQ  
ERNEST D. BUFF & ASSOCIATION  
245 SOUTH STREET  
MORRISTOWN, NJ 07960

12/18/2003

EXAMINER

AUDET, MAURY A

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 12/18/2003

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,062	07/19/2001	Anil K. Saxena	IND1157K	9813

TITLE OF INVENTION: NOVEL PEPTIDES AS NS3-SERINE PROTEASE INHIBITORS OF HEPATITIS C VIRUS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$300	\$1630	03/18/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

## HOW TO REPLY TO THIS NOTICE:

## I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.